

REMARKS

In the October 22, 2004 Office Action, the Examiner:

- Rejected claims 34-39, 41 and 42 due to informalities;
- Rejected claims 11, 12 and 25 under 35 U.S.C. 112, second paragraph, as being indefinite;
- Rejected claims 14-17, 21, 23, 24 and 26-33 under 35 U.S.C. 103(a) as unpatentable over King et al. ("King", U.S. Pat. No. 5,812,572) in view of Stephenson ("Stephenson", U.S. App. No. US 2004/0027688 A1);
- Provisionally rejected claims 1-42 as obviousness-type double patenting in view of copending applications 09/777,917, 10/800,117, and 10/657,554.

Disclosure

The Examiner's attention is drawn to the Information Disclosure Statement ("IDS") that was filed on October 21, 2004. This IDS crossed in the mail with the current Office Action that was mailed by the USPTO on October 22, 2004. The IDS provided the Examiner with copies of a European Search Report and a U.S. patent cited therein, both from a related patent application pending before the European Patent Office. It is noted that the "Transaction History" section of the USPTO's Patent Application Information ("PAIR") website does not show this IDS as being received. Accordingly, please verify that the IDS was indeed received, or contact the undersigned attorney who will immediately transmit a copy of the IDS to the Examiner via Facsimile.

Claim Objections

Regarding misnumbering of the claims, claims 38-43 have been renumbered 37-42, respectively, and the dependency of claim 39 amended accordingly.

Furthermore, claims 34-39, and 41 have been amended to change the "optoelectronic device" to the "optoelectronic transceiver," for consistency. Accordingly, it is respectfully submitted that the Examiner's objections have been addressed.

Claim Rejections - 35 U.S.C. § 112

Claims 11, 12 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, the Examiner states that claims 11 and 12 lack antecedent basis for “the control circuitry.” Claim 11 has been amended to include “control circuitry”. Claim 12 has been amended to depend from claim 11. Accordingly, the amended claims 11 and 12 now provide sufficient antecedent basis for the “control circuitry.”

The Examiner also states that there is insufficient antecedent basis for the “integrated circuit” in claim 25. The term “integrated circuit” in claim 25 has been replaced with “optoelectronic transceiver,” for which sufficient antecedence exists. Accordingly, it is respectfully submitted that the Examiner’s 35 U.S.C. 112 rejections have been addressed.

Claim Rejections - 35 U.S.C. § 103

The Examiner has rejected claims 14-17, 21, 23, 24 and 26-33 under 35 U.S.C. 103(a) as unpatentable over *King* in view of *Stephenson*.

To establish a *prima facie* case of obviousness, three basic criteria must be met, namely:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2) There must be a reasonable expectation of success; and
- 3) The prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure.¹

This set of rejected claims contains three independent claims, namely claims 14, 26 and 29. All three of these independent claims contain the limitation of "a memory interface for allowing a host device to read from host specified locations within the memory in accordance with commands received from a host device." In other words, the host device can read from specific locations within the memory of the optoelectronic transceiver without having to read an entire diagnostics file from the memory. This has many advantages,

¹ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

including speed of data access, reduction in bandwidth used between the optoelectronic transceiver and the host device, improved efficiency, reduced load and wear on the memory, etc.

With regard to this limitation, the Examiner states that *King* discloses "a memory interface 26 for allowing a host to read from host specified locations within the memory in accordance with commands received from a host device (such as computer 90 in Figure 3; column 10, lines 10-18; column 16, lines 58-63)." (Emphasis Added). However, the host computer 90 disclosed by *King* is only able to interrogate or communicate with the microcontroller 50 and not with the PROM, RAM or EEPROM.² There is no teaching in *King* that the host computer can specify memory locations, or any other memory-mapped locations with the laser transmitter module. Further, there is no teaching in *King* about the nature or content of the commands sent by the host computer to the microcontroller 50. Accordingly, *King* does not disclose, teach or suggest a host device that can read from host specified locations within a memory. *Stephenson* also does not disclose, teach or suggest a memory interface for allowing a host to read from host specified locations within the memory. For this reason alone, independent claims 14, 26 and 29, and their dependant claims 15-17, 21, 23, 24, 27-28, and 30-33, cannot be unpatentable over *King* in view of *Stephenson*.

Still further, independent claims 14, 26 and 29 also include the limitations that the digital values are stored in predefined locations within the memory. Although *King* discloses storing information in non-volatile memory,³ *King* does not disclose that the information is stored in predefined locations within the memory. However, it is this very act of storing digital values in predefined locations in the memory that allows the host device of the present invention to read from the host specified locations in the memory, *i.e.*, the host device is able to read from the exact predefined location where the digital values are stored by the analog to digital conversion circuitry. Again, as described above, accessing these host specified locations to read specific data is more efficient than reading all the data from the memory. Again, for this reason alone, independent claims 14, 26 and 29, and their dependant claims 15-17, 21, 23, 24, 27-28, and 30-33, cannot be unpatentable over *King* in view of *Stephenson*.

² See *King* col. 16, lines 58-67, and Figure 1.

³ See *King* col. 13, lines 49-67; col. 14, lines 109.

In light of the above, independent claims 14, 26 and 29, and their dependant claims 15-17, 21, 23, 24, 27-28, and 30-33, cannot be unpatentable over *King* in view of *Stephenson*, as the prior art references do not teach or suggest all of the claim limitations.

Regarding claim 17, the Examiner states that *King* discloses storing a digital power level value in a predefined power level location within the memory (column 16, lines 16-20). However, *King* only discloses using power data and never discloses storing such data, let alone storing the data in a predefined power level location within the memory. Therefore, claim 17 cannot be unpatentable over *King*.

Similarly, regarding claims 21, 27 and 30 the Examiner states that *King* stores a digital temperature value in a predefined temperature location within the memory (column 13, lines 14-64). However, *King* only discloses using temperature data and never discloses storing such data, let alone storing the data in a predefined temperature location within the memory. Therefore, claims 21, 27 and 30 cannot be unpatentable over *King*.

Similarly, regarding claims 28 and 32 the Examiner states that *King* stores a voltage value in a predefined location within the memory (column 16, lines 16-20). However, *King* only discloses using voltage data and never discloses storing such data, let alone storing the data in a predefined location within the memory. Therefore, claims 28 and 32 cannot be unpatentable over *King*.

Double Patenting

The Examiner has provisionally rejected numerous claims under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of copending applications 09/777,917, 10/800,117, and 10/657,554. Pursuant to 37 CFR 1.321(c), Applicants hereby submit a terminal disclaimer to overcome these provisional rejections.

In light of the amendments to the claims, the arguments presented above, and the terminal disclaimer, Applicants respectfully requests that the Examiner reconsider this application with a view towards allowance. The Examiner is encouraged to call the undersigned attorney at (650) 843-4000 should any issues remain unresolved.

Furthermore, if there are any fees or credits due in connection with the filing of this Response, including any fees required for an Extension of Time under 37 C.F.R. Section

1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 060900-0207-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

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 31,066

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